

REMARKS

I. Status of the Claims

Claims 14-25 are currently pending. By this amendment, claim 14 has been amended and claim 25 has been added. Support for the amendment to claim 14 can be found in the Specification at page 12, line 4 to page 5, line 2. Support for claim 25 can be found in the Specification at page 2, line 27 to page 3, line 6. No new matter has been added.

II. Remarks Regarding Status of Claims

As evident on the cover page of the February 8, 2004 Office Action, the Examiner mistakenly indicated that the status of the action is both "final" and "non-final." To clarify this discrepancy, on March 23, 2006 Applicant's representative and the Examiner discussed the status of the Office Action. The Examiner agreed that because the February 8, 2004 Office Action is a first action after the filing of a Request for Continued Examination (RCE) and the Examiner applied new grounds of rejection, the rejection should be non-final. With that in mind, Applicant appreciates the entry of the foregoing amendment.

III. Rejection Under 35 U.S.C. § 102

The Examiner has rejected claims 14-24 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,626,937 to Cox for the reasons set forth on page 2 of the Office Action. Applicants respectfully disagree and traverse the rejection for at least the following reasons:

To establish the anticipation of a claim, the Examiner must show that each element of the claim at issue is found, either expressly or under the principles of inherency, in a single prior art reference. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992) (emphasis added). Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (citations omitted). The Examiner has not met this burden.

As discussed below, Cox does not teach each and every element recited in the present claims, and thus cannot anticipate the present claims. Cox is directed to a stent that is balloon-expandable. Cox at col. 3, lines 44-48 and col. 5, lines 50-65. Like most balloon-expandable stents, the stent of Cox requires an external force to reach the deployed state and is not self-expanding. Cox at col. 6, lines 35-39. Furthermore, Cox distinguishes the balloon-expandable stent from other nitinol stents which cannot be balloon-expandable. Cox at col. 3, lines 44-48.

In contrast, Claim 14 recites, *inter alia*, a shape memory alloy element that "self-expands into the deployed shape when not held by the delivery system." As Cox does not expressly or inherently disclose this element, it does not teach each and every element of the claimed invention. For these reasons, the anticipation rejection is improper and should be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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/Louis Troilo/

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